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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,970	09/11/2003	Beth A. Lange	17890 (27839-1256)	5030
45736 7590 05/22/2009 Christopher M. Goff (27839) ARMSTRONG TEASDALE LLP ONE METROPOLITAN SQUARE SUITE 2600 ST. LOUIS, MO 63102				
EXAMINER CLAYTOR, DEIRDRE RENEE				
ART UNIT 1617		PAPER NUMBER		
NOTIFICATION DATE 05/22/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USpatents@armstrongteasdale.com

### Office Action Summary

**Application No.**

10/659,970

**Applicant(s)**

LANGE ET AL.

**Examiner**

Renee Claytor

**Art Unit**

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-9, 11, 12, 14-19, 21, 22, 24, 25, 27-48 and 50-52 is/are pending in the application.
- 4a) Of the above claim(s) 31-48 and 50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9, 11-12, 14-19, 21-22, 24-25, 27-30, 51-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1, 3-9, 11-12, 14-19, 21-22, 24-25, 27-48, 50-52 are pending with claims 27-48 and 50 withdrawn and claims 1, 3-9, 11-12, 14-19, 21-22, 24-25, 27-30, 51-52 currently under examination.

### ***Response to Arguments***

Applicants argue over the 35 USC 103 rejection over Pospischil in view of Horizumi and Watanabe. In particular, Applicant's argue that Pospischil does not teach a product comprising 40% by weight to about 70% by weight of a water-soluble film forming polymeric material and a solidifying agent and that Horizumi teaches amount of the water-soluble polymer in particular amounts of 0.01-10 wt% and that the cosmetic is applied to the face with holes corresponding to the eyes, nose and mouth. Applicants further argue that one would not be motivated to look to the Watanabe reference because lower amounts of a film-forming agent is taught. Applicants argue that it would not be obvious to optimize the amounts given in the composition to dissolve in a particular time frame because none of the references mention a rate of dissolution.

In response to the above arguments, it is noted that the present claims are composition claims and it is noted that if the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). In the

instant case, the claims are read as composition claims of which the prior art teaches the elements of the composition presently claimed.

It is noted that because the prior art references (Pospischil and Horuzumi) teach treating the face, it is the contention of the Examiner that if the face can be treated then the lips can be treated as well. Just because Horuzumi teaches holes in the cosmetic of the invention does not mean that the lips cannot be treated. Further, the claim limitation of the composition dissolving in no more than 50 seconds, it is noted that this is a property of the ingredients of the composition and if the prior art teaches the same ingredients then it will automatically perform the function of dissolving in no more than 50 seconds. In addition, Horuzumi discloses amounts of the water-soluble polymer up to 50%; therefore, this meets the claim limitation of 40 to 70% of the water-soluble polymer. Horuzumi does not teach that an upper amount is not effective. Further, it would be obvious to optimize the amount of the water-soluble polymer for the cosmetic to increase the strength of the composition as taught by Horuzumi.

Applicants argue over the 35 USC 103 rejection over Fox in view of Horuzumi and Watanabe. In particular, Applicants argue that Fox does not teach water-soluble polymers in amounts of 40 to 70% as claimed in claim 51. It is noted that addressing the higher amounts of the polymers was taught by the secondary reference Horuzumi of which was addressed above.

Accordingly the rejections are deemed proper and are given below for Applicants convenience.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-9, 11-12, 14-18 and 51-52 rejected under 35 U.S.C. 103(a) as being unpatentable over Pospischil (US Patent 3,803,300) in view of Horizumi (EP 1,136,057) and Watanabe (JP 61-176512).

Pospischil teaches shaped ointment bodies which are applied to the skin (Col. 1, lines 32-37). The ointment bodies are foil-shaped and include ingredients such as a film forming agents such as carboxymethyl cellulose in amounts of 3 to 20% (Col 1. lines 54-55; Col. 2, lines 47-50). Also included are humectants such as glycerin and sorbitol (see Examples 1-3) which are taught to be added in amounts ranging from 12 to 40% (Col. 1, line 55). Also included in the compositions are occlusive-type moisturizing agents such as petroleum (see Examples 1-4). Surfactants are also added in the composition (See Examples).

Pospischil does not teach amounts of the water-soluble film forming polymeric material at 40-70%, the solidifying agent or the thickness of the product.

Horizumi teaches a sheet cosmetic composition that is a single-layer (paragraph 0008). The compositions are comprised of a water-soluble polymer which includes carboxymethyl cellulose in amounts of 0.001-50 wt % (paragraphs 0020 and 0021). Horizumi teaches sheets that contain pullulan (see paragraph 0032).

Watanabe teaches that drying and chapping of the lips can be treated by providing to the lips a humectant and an oleaginous wax that is effective to supply to the skin with moderate oiliness, such as olive oil and lanolin (an animal wax; see abstract in particular), and thus teaches the solidifying agents as recited in claims 1 and 10.

Accordingly, it is considered that one of ordinary skill in the art at the time of the invention would have found it obvious to provide water-soluble polymers in higher amounts as taught by Horizumi in the composition of Pospischil and to further include an oleaginous wax as taught by Watanabe. One would be motivated to add the water-soluble polymer in higher amounts to increase the strength of the composition as taught by Horizumi (paragraph 0020) and to add the oleaginous wax to further moisturize the lips as taught by Watanabe.

Regarding the limitation of the capability of the composition to substantially dissolve in a certain amount of time in claims 1 and 14-16, it is noted that the above listed prior art teaches the various ingredients in the compositions, such as the type and the amount of the water-soluble polymer provided, can affect the solubility and dissolution rate of the composition. Accordingly, it is considered that one of ordinary skill in the art at the time of the invention was made would have found it obvious to vary and/or optimize the amount and type of the ingredients provided in the sheet composition, according to the guidance provided by Pospischil, Horizumi and Watanabe, to provide a composition having desired dissolving properties, such as a desired dissolving duration. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable

ranges by routine experimentation". In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Regarding the length of the product as recited in claim 17, it is noted that Pospischil, Horizumi and Watanabe render obvious shaping and configuring the composition for application to the lips, as discussed above. Accordingly, it is considered that one of ordinary skill in the art would have found it obvious based on the teachings of these references to provide a length of the sheet that is suitable to fit on at least a portion of the lips, such as a length of no more than about 8 centimeters, with the expectation of providing a suitable treatment composition for the lips.

Claim 51 rejected under 35 U.S.C. 103(a) as being unpatentable over Fox (US Pg-Pub 2004/0071755) in view of Horizumi (EP 1136057) and Watanabe (JP 61-176512).

Fox teaches compositions in the form of a soluble sheet or film which is used in the personal care field in a soap bar or liquid body wash (paragraph 0006 and 0008). Fox teaches that the base composition includes a water soluble polymer and a humectant (moisturizing agent; paragraph 0009). Fox teaches that the water soluble film releases the skin care ingredients upon exposure to sufficient moisture (paragraph 0005).

Fox does not specifically exemplify a composition having the recited components in the specific weight percentages as claimed or the specific solidifying agents as listed in the claims.

Horizumi teaches a sheet cosmetic composition that is a single-layer (paragraph 0008). The compositions are comprised of a water-soluble polymer which includes carboxymethyl cellulose in amounts of 0.001-50 wt % (paragraphs 0020 and 0021). Horizumi teaches sheets that contain pullulan (see paragraph 0032).

Watanabe teaches that drying and chapping of the lips can be treated by providing to the lips a humectant and an oleaginous wax that is effective to supply the skin with moderate oiliness, such as olive oil and lanolin (an animal wax) (see abstract, in particular), and thus teaches the solidifying agents as recited in claim 51. Accordingly, it is considered that one of ordinary skill in the art at the time of the invention would have found it obvious to provide water-soluble polymers in higher amounts as taught by Horizumi in the composition of Fox and to further include an oleaginous wax as taught by Watanabe. One would be motivated to add the water-soluble polymer in higher amounts to increase the strength of the composition as taught by Horizumi (paragraph 0020) and to add the oleaginous wax to further moisturize the skin as taught by Watanabe.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not



mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Renee Claytor whose telephone number is (571)272-8394. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Renee Claytor

/SREENI PADMANABHAN/  
Supervisory Patent Examiner, Art Unit 1617